

REMARKS

The examiner rejects claims 1-4, 7, 8, 13, 14, 16, and 19-26, as obvious over Petch (WO 98/21897) in view of Sulk (US 5940458). This rejection applies to all independent claims (1, 13, 21, and 24).

Petch teaches synchronizing mobile station master clocks to base station timing to maintain end-to-end synchronization (p. 4, lines 12-22). Petch does not teach or suggest a plurality of base station timing units to provide timing signals to a plurality of base station processor boards; rather, Petch explicitly describes one base station master clock (p. 4, lines 23-33), and states that the base station master clock can be synchronized to a GPS signal (p. 5, lines 14-19).

Providing one base station master clock and synchronizing it to a GPS signal, as is explicitly taught by Petch, has nothing to do with the plainly worded limitations of the rejected claims, which explicitly relate to the use of plural base station timing units for plural base station processor boards. The examiner is wrong in asserting that Petch teaches the plural processor boards receiving timing signals from plural timing units—Petch explicitly describes a single master clock in its disclosed base station architecture. Moreover, Sulk provides no relevant teachings on this point. Indeed, the examiner does not argue that Sulk provides any such teachings and, instead, relies on Sulk only for its alleged teachings regarding the use of a predetermined time offset.

Thus, Petch alone, or in any combination with Sulk, does not teach or suggest all of the limitations of the rejected claims. As clearly explained in Section 2142 of the MPEP (Ed. 8, R. 3), the examiner bears the initial burden of establishing a prima facie case of obviousness, which depends on the argued-for combination of references teaching or suggesting all claim limitations.

Petch does not teach the plural arrangements of base station timing units and processor boards, nor does Sulk—indeed, Petch teaches away from Applicant's claims by teaching the use of a single base station master clock. Thus, the combination of Petch and Sulk fail to establish a prima facie case of obviousness. Notably, when the references cited by the examiner fail to establish the prima facie case of obviousness, *the rejection is improper and will be overturned. In re Deuel*, 51 F.3d 1552, 1557, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995).

Of equal importance, the examiner has failed to make any legally sufficient showing of a motivation to combine Sulk with Petch. For example, the Office Action states that Sulk teaches controlling a local timer based on comparison to a predetermined offset, and that such teachings would have been obvious to combine with Petch the comparator and processor of Sulk related to Sulk's time offset processing. Respectfully, that statement does not mean anything in the context of Petch or Sulk. Petch teaches a single base station master clock that is synchronized to a GPS signal. Sulk teaches compensating for errors in a time/frequency generator according to a rather involved frequency/time error estimation process.

It is no more than rank conjecture to argue that one would be motivated to add Sulk's timing compensation circuit to Petch. Petch does not identify GPS synchronization as its problem, nor does it even allude to any GPS-related synchronization challenges. Rather, Petch allegedly addresses the problem of keeping remote mobile stations aligned with the base station timing. There is nothing in the record that suggests Sulk's timing synchronization is any better than Petch's timing synchronization, or that anything would be gained by substituting Sulk's synchronization for Petch's synchronization. In short, it appears that the examiner uses Sulk for no more

than its “keyword” value—i.e., Sulk explicitly mentions predetermined time offsets, where Petch does not.

In short, the examiner’s proffered motivation to combine Sulk with Petch is nothing more than a conclusory statement of the type that is routinely held to fail as a matter of law. More specifically, the showing made by the examiner regarding the suggestion or motivation to combine must be clear and particular, and board conclusory statements about the teachings of the references making up the argued-for obviousness combination are not evidence of any motivation. Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). More pointedly, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP, 2142. Specifically, “to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

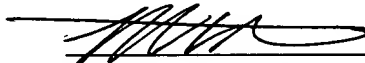
Legally sufficient evidence of the motivation to combine Petch with Sulk is absent from the record, and the obviousness rejection fails for that reason alone. Additionally, the combination of Petch with Sulk fails to teach or suggest all of the limitations of the claims rejected over that argued-for combination. The obviousness rejection further fails for that reason.

For at least the reasons given above, the obviousness rejections based on Petch fail as a matter of law and must be withdrawn. As such, it is believed that all independent claims (1, 13, 21, and 24) and, therefore, all dependent claims, stand in condition for allowance, and an indication as such from the examiner is respectfully

requested. (Note, too, that the examiner's rejections of selected dependent claims based on Petch in combination with various other references are moot in view of the allowability of all independent claims.)

Respectfully submitted,

COATS & BENNETT, P.L.L.C.



Michael D. Murphy
Registration No.: 44,958

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P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844
Facsimile: (919) 854-2084